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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,746	04/01/2004	Wray Russ	033131-015	1370

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EXAMINER

LAZOR, MICHELLE A

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/816,746

Applicant(s)

RUSS, WRAY

Examiner

Michelle A Lazor

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/04 & 8/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 23 – 25 and 27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 27, 28, 32, and 29, respectively, of copending Application No. 10272325. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims 23 – 25 and 27 fully encompass Claims 27, 28, 32, and 29 of Application No. 10272325 since the claim does not limit the conveyor belt to have a plurality of belts forming the conveyor surface, and does not require at least one sensor for directing the marking of the medium.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 23 and 24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10820247 in view of Ozawa (U.S. Patent No. 6332680).

Copending Application No. 10820247 discloses all the limitations of Claims 23 and 24, but does not specifically disclose a housing for stacking a plurality of mediums. However, Ozawa discloses a housing (612) (Figure 4). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to include a housing to maintain an appropriate stack from which to dispense media from.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claim 26 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 27 of copending Application No. 10272325 in view of Ozawa.

Copending Application No. 10272325 discloses all the limitations of Claim 25, but does not disclose a housing adapted to receive the medium from the conveyor belt surface, the housing having a guide member, at least one support member, and a base member; as well as a removable hopper adapted to receive the medium from the guide member, the hopper comprising a spindle attachable to a base, wherein the spindle is adapted to receive a plurality of mediums from the guide member. However, Ozawa discloses a housing (612) adapted to receive the medium from the conveyor belt surface, the housing having a guide member (619), at least one support member (618), and a base member; as well as a removable hopper (611) adapted to receive the medium from the guide member, the hopper comprising a spindle (615) attachable to a base (614), wherein the spindle is adapted to receive a plurality of mediums from the guide member (Figure 4; column 6, lines 13 – 59). Therefore it would have been obvious to one of

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ordinary skill in the art at the time of the invention to include a receptacle with the above limitations to more easily conduct the insertion operation (column 6, lines 58 – 59).

This is a provisional obviousness-type double patenting rejection.

Claim Objections

5. Claims 8 and 18 are objected to because of the following informalities: The word “remove” is misspelled, and currently reads “remover”. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claim 4 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in the specification (Figure 16; paragraphs 105 – 106). In that paper, applicant has stated the first end of the spindle has a slightly smaller diameter than the second end to assist the disk in sliding down the spindle, and this statement indicates that the invention is different from what is defined in the claim(s) because Claim 4 states the second end has a diameter that is larger than the hole in the platform that receives disks from the guide member. According to the drawing (Figure 16), the platform fits over the spindle, indicating the spindle diameter is smaller than the platform diameter; if this was not the case, the platform would not be able to be pushed down as more disks were being dispensed onto said platform. Therefore for the purpose of examination, Examiner has assumed the limitation of Claim 4 to read “...the second end has a diameter less than a diameter of the hold in the platform...”

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8. Claim 17 recites the limitation "the medium" in line 3. There is insufficient antecedent basis for this limitation in the claim. For the purpose of examination, Examiner has assumed the limitation to read "the disk" to be consistent with the language of the claims to which it is dependent.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 12 and 19 – 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Ozawa.

Ozawa discloses an in-line marking system comprising a dispenser (5) for dispensing markable mediums having a central hole; a conveyor belt assembly; a marking device; and a receptacle (61) adapted to accept the medium after marking that is detachable from the conveyor belt assembly (column 4, lines 11 – 60), the receptacle comprising: a housing (612), considered to be detachable (since this is an apparatus with multiple parts that are all individually attached and can therefore be unattached by a variety of means), and adapted to receive the medium from the conveyor belt assembly, the housing having a guide member considered to be the top of the housing, at least one support member or walls of the housing, and a base member; and a removable hopper (611) adapted to receive the medium from the guide member, the hopper comprising a spindle (615) attachable to a base, wherein the spindle is adapted to receive a plurality of mediums from the guide member, and a hopper guide (615a) adapted to position the

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hopper within the housing (Figures 1 and 4; column 6, lines 13 – 60). Thus Ozawa discloses all the limitations of Claims 12 and 19 – 21, and anticipates the claimed rejection.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1, 2, 5 – 7, 9 – 11, 13, 15 – 17 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ozawa as applied in Claim 22 above, in view of Wolfer et al. (U.S. Patent No. 6123020).

Ozawa discloses all the limitations of Claim 22, including a spindle in the hopper; a platform (616) adapted to receive the disk from the guide member; and an elastic body or spring (617) positioned between the base and the platform (Figure 4; column 6, lines 13 – 30), but does not disclose the hopper to comprise a plurality of posts affixed to a base, nor does it disclose two guide members, the first guide member to comprise a plate like member having a circular opening adapted to guide the disk into the hopper that includes at least one stop and the second guide member configured to control the movement of the medium in a vertical direction. However, Wolfer et al. disclose a plurality of posts (54, 56, 58) affixed to a base, which forms a hopper (Figure 2), and discloses two guide members (60) (62) that include means for a stop (74) (column 3, line 29 – column 4, line 11). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to design the hopper with posts as an equivalent, alternative design to using a cylinder; and it would have been obvious to one of

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ordinary skill in the art to include two guide members in the housing that include means for a stop to simply, reliably and accurately dispense disks into the removable hopper (column 1, lines 54 – 56).

13. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ozawa and Wolfer et al. as applied in Claim 1 above, in view of Pottier (U.S. Patent No. 6494309).

Ozawa and Wolfer et al. disclose all the limitations of Claim 1, including the spindle being attachable to a base (Ozawa: Figure 2), but do not specifically disclose the spindle to have a tapered second end wherein the second end has a diameter less than a diameter of the hole in the platform such that the tapered end of the spindle extends through the hole in the platform. However, Pottier discloses using a tapered second end of a spindle wherein the second end has a diameter less than a diameter of the hole in the platform such that the tapered end of the spindle extends through the hole in the platform (Figure 1; column 4, lines 9 – 19). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to design the second end so that it is tapered as claimed so that the disks may be easily threaded over said spindle (column 4, lines 16 – 17).

14. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ozawa and Wolfer et al. as applied in Claim 1 above, in view of Dinh et al. (U.S. Patent No. 6312522).

Ozawa and Wolfer et al. disclose all the limitations of Claim 1, including removing from the housing (612) the hopper (611) (Ozawa: column 6, lines 48 – 51), but do not specifically disclose a handle adapted to remove the hopper from the housing. However, Dinh et al. disclose using a handle adapted to remove a hopper carrying discs from a housing (Figure 4; column 6, lines 31 – 54 and column 6, line 65 – column 7, line 36). Therefore it would have been obvious

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to one of ordinary skill in the art at the time of the invention to use a handle adapted to remove the hopper from the housing to facilitate handling (column 6, lines 50 – 55).

15. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ozawa as applied in Claim 12 above, in view of Pottier.

Ozawa discloses all the limitations of Claim 12, including the spindle being attachable to a base (Figure 2), but does not specifically disclose the spindle to have a tapered second end wherein the second end has a diameter less than a diameter of the hole in the platform such that the tapered end of the spindle extends through the hole in the platform. However, Pottier discloses using a tapered second end of a spindle wherein the second end has a diameter less than a diameter of the hole in the platform such that the tapered end of the spindle extends through the hole in the platform (Figure 1; column 4, lines 9 – 19). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to design the second end so that it is tapered as claimed so that the disks may be easily threaded over said spindle (column 4, lines 16 – 17).

16. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ozawa as applied in Claim 12 above, in view of Dinh et al..

Ozawa discloses all the limitations of Claim 12, including removing from the housing (612) the hopper (611) (column 6, lines 48 – 51), but does not specifically disclose a handle adapted to remove the hopper from the housing. However, Dinh et al. disclose using a handle adapted to remove a hopper carrying discs from a housing (Figure 4; column 6, lines 31 – 54 and column 6, line 65 – column 7, line 36). Therefore it would have been obvious to one of ordinary

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skill in the art at the time of the invention to use a handle adapted to remove the hopper from the housing to facilitate handling (column 6, lines 50 – 55).


Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle A Lazor whose telephone number is 571-272-1232.

The examiner can normally be reached on Thurs - Fri 5:45 - 4:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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